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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,568	03/21/2005	Pierre Gerard Niewland	NTZ0106 PCT	5036
27256	7590	06/19/2007		
Dickinson Wright PLLC 38525 Woodward Avenue Suite 2000 Bloomfield Hills, MI 48304			EXAMINER KURTZ, BENJAMIN M	
			ART UNIT 1723	PAPER NUMBER
			MAIL DATE 06/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,568	Applicant(s) NIEWLAND ET AL.	
	Examiner Benjamin Kurtz	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 11-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: The oath or declaration is not signed by the applicants.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16, 17 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16 and 17 recite the limitation "the oil inlet port". There is insufficient antecedent basis for this limitation in the claim. For examination purposes the oil inlet port is assumed to be the inlet port.

Claim 25 recites the limitation "said by-pass". There is insufficient antecedent basis for this limitation in the claim. For examination purposes said by-pass is assumed to be the by-pass mechanism.

Claims 26 and 27 are rejected as containing the same defect by depending from claim 25.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11-18, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Malecot et al. WO00/07691 (US 6 874 642 English translation).

Regarding claim 11, Malecot teaches a filtering device comprising: a filter part (14) having a microfiltration device (col. 4, lines 27-30) wherein axial end faces of the filtering part are formed by the microfiltration device, a filter housing (12) comprising a lid (18), a clamping mechanism securing the lid to the housing, an inlet port (22) situated outside the filter part, an outlet port (24) in fluid communication with a cylindrical interior space (30) of the filter part, internal substantially flat filter face contacting faces and a closing face (the face of (20) opposite the filter part) integrated into an insert member accommodating irregularities in shape of the housing at an axial side of the insert member opposing the closing face (where the housing connects to (20)) (fig. 1).

Regarding claims 12 and 18, Malecot further teaches an oil passage closing face is integrated into a housing part (fig. 1); and wherein the oil passage closing face is integrated in a housing wall part (20) having a thickness of more than twice the thickness of a majority of the corresponding housing wall part (fig. 1).

Regarding claims 13-17, Malecot further teaches a radial thickness of the microfiltration device is larger than a radial thickness of its interior space within said

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housing (fig. 1); the microfiltration device has a diameter substantially equal to that of the filter part (fig. 1); the housing comprises a dimple (the portion between (32) and the lip connecting to (12) of (20)); and the inlet port is positioned radially outside the filter part (fig. 1).

Regarding claims 21 and 22, Malecot further teaches at least one closure member sealingly engaging an axial end face of the filter part (fig. 1); and the closure member includes a cylindrical notch (32) adapted to fit in said cylindrical interior space of the filter part (fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 19, 20 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malecot '691 in view of Shoup US 3 970 557.

Regarding claims 19 and 20, Malecot teaches the filter device of claim 11 but does not teach a by-pass mechanism. Shoup teaches a filter device comprising a by-pass mechanism (18) comprising a spring or valve (fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the by-pass mechanism of Shoup because it allows fluid to continue to flow if the filter element becomes clogged or otherwise damaged and non-functional (col. 2, lines 4-10).

Regarding claim 24, Malecot teaches the filter device of claim 11 but does not teach a by-pass mechanism. Shoup teaches a filter device comprising a by-pass mechanism (18) formed by an aperture provided in a closing member (19), which sealingly engages an axial end face of a filter part (16), the aperture connecting the interior space in the filter part to a space exterior to the filter part (fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the by-pass mechanism of Shoup because it allows fluid to continue to flow if the filter element becomes clogged or otherwise damaged and non-functional (col. 2, lines 4-10).

Regarding claims 25-27, Shoup further teaches the by-pass mechanism comprises a valve mechanism movable between a closed position at a lowest operating pressure to an open position as a function of increasing operating pressure (fig. 1); the valve mechanism is pressure dependent and comprises an elastically deformable device (the spring) providing an internal passage which opens up as a function of increasing pressure (fig. 1); and the valve mechanism is at least partially incorporated in said aperture of and end face closing member (fig. 1).

Regarding claim 23, Malecot teaches the filter device of claim 21 but does not teach at least one closure member contacting the housing by way of a spring. Shoup teaches a filter device wherein a closure member (19) contacts the housing by way of a spring (17) (fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the housing configuration of Shoup because the filter element is held in position by the biasing of the spring and holds the filter element in place providing a clamping force to retain the filter (col. 1 lines 64-68).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Kurtz whose telephone number is 571-272-8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin Kurtz
Patent Examiner 1723
6/6/07

BK/Men
Primary Examiner